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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,639	07/19/2006	Atsushi Matsutani	292764US8PCT	5943
22850 7590 05/17/2011 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER HARVEY, DAVID E				
ART UNIT		PAPER NUMBER		
2481				
NOTIFICATION DATE		DELIVERY MODE		
05/17/2011		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/586,639

Applicant(s)

MATSUTANI, ATSUSHI

Examiner

DAVID E. HARVEY

Art Unit

2481

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 2, 4-8 and 11 is/are allowed.
- 6) ☒ Claim(s) 9 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-945)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. The following is noted:

1) That, in addition to the "means for ..." terminology, the following non-exhaustive list of non-functional terms may likewise invoke Section 112-6:

- a) "mechanism for ...";
- b) "module for ...";
- c) "device for ...";
- d) "unit for ...";
- e) "component for ...";
- f) "element for ...";
- g) "member for ...";
- h) "apparatus for ..."
- i) "machine for...";
- j) "system for ...";
- k) etc,...

It is noted, however, that "circuit for" has been determined to be a "structural term" that does not invoke section 112-6.

[e.g., SEE: Federal Register/Vol.76, No. 26/Wednesday, February 9, 2011 @ first full paragraph of center column on page 7167];

2) For a computer-implemented means-plus-function claim limitation that invokes 35 112, sixth paragraph, the corresponding structure is required to be more than simply a general purpose computer or microprocessor.¹ The corresponding structure for a computer-implemented function must include the algorithm as well as the general purpose computer or microprocessor.² The written description of the specification must at least disclose the algorithm that transformed the general purpose microprocessor to a special purpose computer

¹ See *Aristocrat Technologies Inc. v. International Game Technology*, 521 F.3d 1328, 1333, 86 USPQ2d. 1235, 1239-1240 (Fed. Cir. 2008)

² See *WMS Gaming, Inc. v. International Game Technology*, 184 F.3d 1339, 51 USPQ2d. 1385 (Fed. Cir. 1999)

programmed to perform the claimed function.³ Applicant may express the algorithm in any understandable terms including as a mathematical formula, in prose, in a flow chart, or in any manner that provides sufficient structure.⁴

2. Section 112-6 issues & allowability:

- 1) In accordance with item 1 above, it is noted that independent claims 1 and 11 have been construed as invoking Section 112-6.
- 2) The Examiner agrees with the stated correspondence between the recited "means" and the disclosed structure pertaining thereto as set forth on pages 10-11 of the response filed 2/28/2011. The examiner notes these arguments cite steps SP100 –SP109 of Figure 25 as being the corresponding structure/acts of the recited "program table creating means". The examiner maintains that claims 1 and 11 avoid the art of record for at least this reason.
- 3) Turning to the independent claims 9 and 10, it is noted that the "steps" therein do not invoke Section 112-6.

³ See *Aristocrat*, 521 F.3d at 1338, 86 USPQ2d. at 1243.

⁴ See *Finisar Corp. v The DIRECTV Group Inc*, 523 F.3d 1323, 1340, 86 USPQ2d. 1385 (Fed. Cir. 1999)

3. The following "prior art" is noted:

Each of US Patent #7,188,356 to Miura et al (@ Figure 5); US Patent #7,665,108 to Park et al (@ lines 10-45 of column 5; and US Patent #7,930,723 to Mikkelsen (see abstract); were cited as being illustrative of EPG systems which permitted access to past programs.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication #2007/0277201 to Wong in view of US Patent Document #2003/0061618 to Horiuchi et al. and Japanese Patent Document #JP 2003-31927 to Matsugami (machine generated translation previously provided).

I. Preface:

The examiner maintains that, as currently drafted, the recited "setting step" of claim 9 can fairly be read on a "search request" entered by the user for searching an EPG located at a remote location based on station/channel and time criteria.

2. The showing of Wong:

As is shown in Figure 2 and 18, Wong discloses a video recording device that included:

- 1) Circuitry (@ 200) for receiving a broadcast signal;
- 2) Circuitry (e.g., @ 170 and Figure 9) for setting a broadcast time (@ 510 of Figure 9) and broadcasting station (@ 514 of Figure 9);
- 3) Circuitry (@250) for transmitting request information to a remote server based on the set information;
- 4) Circuitry (@ 250) for receiving reply information;
- 5) Circuitry (@ 180) for creating a program table (e.g., @ 520 of Figure 9);
- 6) Circuitry (@ 180) for scheduling the recording of the selected program (@ 544 of Figure 9).

3. Differences:

Claim 9 differs from the showing of Wong only in that:

- 1) Wong does not describe the requested information as including all of titles and broadcasting dates and times; and
- 1) Wong does not describe the time period (@ 510) as including a past time period option.

III. Obviousness:

A) As is shown in Figure 1, Horiuchi et al described a system in the same filed of endeavor as that described by Wong. Horiuchi et al evidences that it was known/conventional in such systems for the requested/rely information to have includes titles and broadcast dates [note paragraph 0025]. The examiner maintains that it would have been obvious to have provided such information with the reply information in Wong to better inform the user of the content which is available for recording.

B) Matsugami evidences the fact that it was known in the art to have modified receivers:

- 1) To permit the user to select the EPG data pertaining to past programs; and
- 2) To advantageously utilize the selected EPG data of past programming as the basis for searching the EPG data of future programming to find EPG information corresponding to a rebroadcast of the past programming and, thereby, enabling the system to schedule the recording of previously missed/overlooked programs.

[e.g., note paragraphs 0024-0026 the provided translation]

The examiner maintains that it would have been obvious to one of ordinary skill in the art to have further modified the system disclosed by Wong to include this clearly desirable capability; i.e., the ability to subsequently record missed/overlooked programming based on the EPG data of the past missed/overlooked programming.

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication #2007/0277201 to Wong in view of US Patent Document #2003/0061618 to Horiuchi et al. and Japanese Patent Document #JP 2003-31927 to Matsugami (machine generated translation previously provided) for the same reasons that were set forth above with respect to claim 9.

7. Claims 1-2, 4-8, and 11 are allowed.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID E. HARVEY whose telephone number is (571) 272-7345. The examiner can normally be reached on M-F from 6:00AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Peter-Anthony Pappas, can be reached on (571) 272-7646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DAVID E HARVEY/
Primary Examiner, Art Unit 2481

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